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09/922,489	08/06/2001	Khai Hee Kwan		9184

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KHAI HEE KWAN  
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MALAYSIA

EXAMINER
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MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/922,489

Applicant(s)

KWAN, KHAI HEE

Examiner

Susanna M. Diaz

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 30-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 30-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_

- 5) ☐ Notice of Informal Patent Application

- 6) ☒ Other: Requirement for Information Under 37 CFR § 1.105

### **DETAILED ACTION**

1. Claims 30-59 are presented for examination.

#### ***Claim Objections***

2. Claims 33, 36, and 37 are objected to because of the following informalities:

Claim 33, line 2, delete "in formation", insert --information--

Claim 36, line 6, delete "enrolment", insert --enrollment--

Claim 37, line 7, delete "utilising", insert --utilizing--

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 30-59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites the limitation "the education option price" in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, "the education option price" will be interpreted as "an education option price."

Claims 38-45 each recite an apparatus "adapted to implement the method of [a preceding claim]"; however, the apparatus elements (i.e., "at least one data terminal communicating to a central controller") are not clearly correlated to the functionality

Art Unit: 3694

which each performs. Furthermore, the phrase "adapted to implement" is vague and indefinite since it merely signifies that the structure is capable of performing functionality. In other words, such a phrase fails to expressly set forth the metes and bounds of Applicant's invention. Similarly, without explicitly setting forth in the body of each claim which particular structural element performs which specific functionality, the intended scope of each claim is further ambiguous. It is respectfully recommended that the Applicant write out each of claims 38-45 clearly as an independent claim, setting forth in the body of each claim which apparatus elements actively perform (and are not just "adapted to implement") each step.

Claims 46-50 recite "computer executable software code stored on a computer readable storage medium implementing the method of [a preceding claim]." Claims 46-50 fail to further limit the claims from which they depend, which is improper. Claims 46-50 should each be written out as independent claims that expressly incorporate the desired method steps that are to be executable in each claim.

Claim 51 recites the limitation "the education course price" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, "the education course price" will be interpreted as "a price of the selected education option price."

In the last two limitations recited in claim 52, it is not clear which structural element of the apparatus performs the steps of "to calculate..." and "outputting." Functionality must be tied into the structural elements of an apparatus in order to merit

Art Unit: 3694

patentable weight. Please amend claim 52 to clarify which structural element(s) performs each of these steps.

Use of the phrase "adapted to" throughout claims 53-58 renders the scope of each respective claim vague and indefinite since "adapted to" merely sets forth what a structural element is capable of doing and does not positively recite that the structural element expressly performs the functionality in question. The "adapted to" language should be replaced with more positively recited language. For example, instead of stating that "element A is adapted to perform function X," it should be stated that "element A performs function X."

Claim 59 recites the limitation "the education option price" in line 4 of the claim. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, "the education option price" will be interpreted as "an education option price."

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 30-35, 37-43, 45-49, and 51-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cincotta (US 2002/0004782).

Cincotta discloses a method for user to contract a future education fee amount now for an education course and optionally paying for the said contracted education fee in the future subject to gaining admission to said course, comprising the steps:

[Claim 30] receiving education information from user (Fig. 1; ¶¶ 22-24, 40-65 -- The Beneficiary's information must be provided to the Administrating Company in order to determine accurate option prices);

in response to the said information, calculating the education option price in consideration to contract the future education fee amount as determined by the user's education information where the price gives a right but not an obligation to pay the said contracted fee for the selected course on the condition of being offered admission to selected source by selected institution before commencement date of selected course (¶¶ 27, 33, 40-65 -- One of the categories used to assess a Beneficiary's probability of attending an educational institution in the future is MAJOR, which represents a type of course, as seen in ¶¶ 47 and 49);

outputting the education option price for consideration by user (¶¶ 33-34, 37 -- The Participant is made aware of the contract, thereby indicating that he/she is made aware of the education option price);

a step for user to pay for the education option (¶¶ 32-33); and

whereby user is a potential student, parents, guardian or benefactor (¶ 26);

[Claim 31] wherein the step of receiving education information comprising:

at least *one of* the first information describing the future education fee amount to be contracted (¶¶ 42, 59, Table A), second information concerning the desired number

Art Unit: 3694

of years before commencement of the selected course (¶¶ 43, 47, 49, Table A), third information concerning user past academic results (¶¶ 48, 57-58, 65), fourth information concerning user personal data (¶¶ 50-58), fifth information concerning the selected institution (¶¶ 40-65), sixth information concerning the selected course (One of the categories used to assess a Beneficiary's probability of attending an educational institution in the future is MAJOR, which represents a type of course, as seen in ¶¶ 47 and 49), seventh information concerning the user's flexibility factor of the selected course [Only one of the listed factors needs to be taught by the prior art in order to fully address the claim limitation because of the "at least one of" language];

[Claim 32] receiving an indication that a user has purchased the education option and updating a database to reflect the sale of the said option (¶¶ 36, 68);

[Claim 34] receiving tender of the purchase price from the user (¶¶ 32-33);

scanning for any available ready seller at that price or lower (¶ 36);

if available performing a transaction to sell the education option to the user (¶¶ 32-33); and

storing information regarding said option until expired or exercised whichever is first (¶¶ 27, 36, 68, 72);

[Claim 35] receiving a request from a user to exercise the education option (¶ 68);

verifying if user has been admitted to the selected course (¶ 66); and

update the transaction (¶¶ 36, 68);

[Claim 37] receiving at least *one of* first information describing a desired number of years before commencement of course, second information concerning the expected

Art Unit: 3694

enrollment demand on the subject course, and third information concerning the volatility of the selected education course prices, and fourth information concerning the desirability of the user, and fifth the flexibility of the user's education plans (¶¶ 40-65) [Only one of the listed factors needs to be taught by the prior art in order to fully address the claim limitation because of the "at least one of" language], and

wherein said calculating step further includes utilizing at least *one of* the said first information, said second information, said third information, said fourth information, said fifth information to calculate the education option price (¶¶ 40-65) [Only one of the listed factors needs to be taught by the prior art in order to fully address the claim limitation because of the "at least one of" language].

Regarding claim 30, Cincotta does not expressly teach that the user directly provides his/her information over a network; however, the user's education information is uploaded to a central server for processing (¶¶ 22-24). Cincotta merely fails to explicitly state how the user communicates this information to the Administering Company. However, Official Notice is taken that it is old and well-known in the art of financial planning for a customer to request financial services from and submit payment electronically to the company assisting him/her with such requests over a network in order to quickly and efficiently facilitate transactions among remotely located parties. Since the success of Cincotta's invention relies on the ability of the Administering Company to reach as large of a customer base as possible, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's



invention to modify Cincotta such that the user directly provides his/her information over a network to the Administering Company in order to quickly and efficiently facilitate transactions among remotely located parties. This provides the users with the added convenience of not having to travel to the location of the Administering Company and its customer service representatives.

Regarding claim 33, Cincotta evaluates an education option sales price based on historical information regarding each Beneficiary and an Institution's statistics (¶¶ 40-65); however, Cincotta does not expressly teach the step of receiving education option sales information from an option database indicating a number of similar options that have been previously sold or written, and wherein the calculating steps use the option sales information in determining the option price. However, Official Notice is taken that it is old and well-known in the art of price optimization to set a price for a product based on the prices set for comparable items. This allows a seller of the product to gauge a reasonable price of the product in its respective market. Since Cincotta's Administering Company benefits from an optimal option price (that maximizes the Administering Company's profit while making the price reasonable enough that Participants can afford and be motivated to purchase the option), the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Cincotta to perform the step of receiving education option sales information from an option database indicating a number of similar options that have been previously sold or written, and wherein the calculating steps use the option sales information in

Art Unit: 3694

determining the option price in order to allow the Administering Company to more accurately gauge a reasonable price of the education option in its market.

As per claim 35, when an option is exercised and the Beneficiary has been accepted to an Institution and inherently its courses (§ 66), the Administering Company provides a voucher to the Participant who then presents it to the educational Institution (§§ 68-69), yet Cincotta does not expressly teach that if acceptance of the Beneficiary to a selected course is verified, then performing an online financial transaction to pay the contracted education fee contracted in the education option. In other words, Cincotta does not explicitly state if the financial transaction is performed on- or off-line. However, Official Notice is taken that it is old and well-known in the art of financial transactions to transfer funds online (e.g., over a network, such as the Internet). Such a practice quickly and efficiently facilitates financial transactions among remotely located parties. Since many educational institutions are located remotely from educational finance plan administrators and educational finance plan participants (e.g., parents and grandparents of a beneficiary), the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Cincotta such that if acceptance of the Beneficiary to a selected course is verified, then performing an online financial transaction to pay the contracted education fee contracted in the education option in order to quickly and efficiently facilitate payment of the education voucher to the educational Institution.

Art Unit: 3694

[Claims 38-43, 45-49] Claims 38-43 and 45-49 recite limitations already addressed by the rejection of claims 30-35 and 37 above; therefore, the same rejection applies.

Furthermore, it should be noted that Cincotta discloses a central controller and software "adapted to" perform the recited functionality (Fig. 1; ¶¶ 22-24).

[Claims 51-58] Claims 51-58 recite limitations already addressed by the rejection of claims 30-35, 37-43, and 45-49 above; therefore, the same rejection applies.

Furthermore, it should be noted that Cincotta discloses a central controller and software "adapted to" perform the recited functionality (Fig. 1; ¶¶ 22-24).

#### ***Allowable Subject Matter***

7. Claim 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

8. Claims 44, 50, and 59 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Conclusion***

9. This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to

Art Unit: 3694

the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3694

January 5, 2007

***Requirement for Information Under 37 C.F.R. § 1.105***

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of determining education option prices.

In response to this requirement, please provide the citation and a copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to developing the option price equation recited in claims 36 and 59. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter, if any.

2. The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement

under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

3. This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is THREE (3) months.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

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Susanna M. Diaz  
Primary Examiner  
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January 5, 2007



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